

REMARKS

Claims 17, 19-28 and 32-35 remain in this application. Claims 17, 25-28 and 32-35 have been amended to define still more clearly what Applicants regard as their invention, in terms which distinguish over the art of record. Claims 17 and 25-28 are independent. Favorable reconsideration is respectfully requested.

Request to Vacate Improper Finality

The Advisory Action dated August 23, 2004, denied entry to the Amendment After Final Rejection dated June 16, 2004, on the ground that that Amendment raised issues requiring further consideration or search, or both. Accordingly, it was improper to make the outstanding Office Action final:

“However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.” MPEP § 706.07(b).

The Prior-Art Rejection

In the outstanding Office Action, Claims 17, 19-28 and 32-35 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 5,913,019 (Attenberg) in view of U.S. Patent 5,487,010 (Drake et al.).

Independent Claim 17 is directed to a sticker printing apparatus for printing a desired sticker by operating a touch panel overlaid on a display screen. The apparatus of Claim 17 comprises selection means for selecting one of a plurality of background patterns displayed on the display screen by using the touch panel, and background image display

means for displaying on the display screen a background image corresponding to the selected background pattern and storing, in a predetermined storage, the background image as one of a plurality of logical layers which overlie each other in a fixed order. Also provided are input means for inputting, by using the touch panel, a plurality of character strings to be printed on a sticker, each of the plurality of character strings being assigned to each of the plurality of logical layers. Control means generate a set of bitmap image data corresponding to an inputted character string and store the bitmap image data in the predetermined storage, each time a character string is inputted by the input means, and layout means lay out each of the stored sets of bitmap image data in accordance with the fixed order. Also provided are generating means for generating image data by overlaying each of the resulting sets of image data on the background image, and when a desired layer to be edited is designated by using the touch panel with regard to image data obtained by the generating means, edit means edit the designated layer and re-generate image data by overlaying bitmap image data of the edited layer and bitmap image data of non-edited layers in accordance with the fixed order. Output means, when an output instruction is inputted by using the touch panel, output the image data, obtained by the generating means or the edit means, to printing means.

Among other important features of the apparatus of Claim 17, is that plural bitmap images forming a sticker are managed independently as logical layers assigned to respective bitmap images, and as a result, a user can edit just a desired layer even when

several or all of the layer images have been set. As shown in Fig. 13, the user can return to a desired layer processing for re-editing the designated layer only.¹

Attenberg relates to an interactive photo kiosk that permits a user to make a photograph of the user against a computer-generated background, a number of which are available for selection by the user. Once the user has selected the desired background, the resulting image stored in digital form is used to produce an image containing multiple instances of the desired image, and this multiple image can be printed out with each repetition of the selected image made to be peeled off from the backing sheet of the print (see Fig. 2A, S94 and S95).

Applicants submit, however, that nothing has been found in *Attenberg* that would teach or suggest the re-editing function, or means for such editing, recited in Claim 17 (the editing means). According to *Attenberg*, once a user selects both a background image and a foreground image, the user cannot change just the background image while keeping the foreground image. An apparatus according to Claim 17, in contrast, affords the user the ability to edit any designated layer. For at least this reason, Claim 17 is believed to be clearly allowable over *Attenberg*, taken alone.

Moreover, even if *Drake* is deemed to show all that it is cited for, the result of the proposed combination of those two patents (even assuming that combination would be a permissible one), would not meet the terms of Claim 17.

^{1/} As always, it is to be understood that the claim scope is not limited by the details of the embodiments referred to.

Independent Claim 27 is directed to an apparatus for printing a desired sticker by operating a touch panel overlaid on a display screen, that comprises start-up means for initiating start-up operation from a read-only storage medium which stores an operating system (OS), and preliminary processor means for copying data, which is stored in the storage medium and is subject to being written at least while the OS is operating, to secondary volatile storage means that have a filing system and are accessible by a CPU in a first stage. Also provided are means for initiating the OS to operate in a second stage which is after operation is performed by the preliminary processor means, and selection means for selecting one of a plurality of background patterns displayed on the display screen by using the touch panel. Background image display means display on the display screen a background image corresponding to the pattern selected by the selection means and store, in a predetermined storage, the background image as one of a plurality of logical layer which overlies each other in a fixed order. Input means input, by using the touch panel, a plurality of character strings to be printed on print paper under the operation of the OS, each of the plurality of character strings being assigned to a respective one of the plurality of logical layers. Control means are provided for generating sets of bitmap image data corresponding to an inputted character string and storing the bitmap image data in the predetermined storage, each time a character string is inputted by the input means, and layout means lay out each set of the stored bitmap image data in accordance with the fixed order. Generating means are provided for generating image data by overlaying each of the image data obtained by the layout means on the background image, and edit means, when a

desired layer to be edited is designated by using the touch panel with regard to the image data obtained by the generating means, edit the designated layer, and re-generate image data by overlaying bitmap image data of the edited layer and bitmap image data of non-edited layers in accordance with the fixed order. Output means, when an output instruction is inputted by using the touch panel, outputting image data obtained by the generating means or the edit means, to printing means.

According to Claim 27, thus, the apparatus can boot from a read-only storage medium and can serve as an apparatus for printing a desired sticker. Since the claimed apparatus does not need a non-volatile writable storage such as a hard drive, the apparatus can be started or shut down stably by simply turning the main switch on or off, respectively (see from page 13, line 23, to page 16, line 24, of specification).

Applicants submit that nothing has been found, or pointed out, in *Attenberg* or *Drake* that would teach or suggest the start-up means, preliminary processor means or initiating means, or the editing means, of Claim 27, and for at least those reasons, that claim is believed to be clearly allowable over those two patents, taken separately or in any possible combination.

Each of the other independent claims corresponds to one or the other of Claims 17 and 27, discussed above, and each is accordingly deemed allowable for at least the reasons presented above.

A review of the other art of record has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as

references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

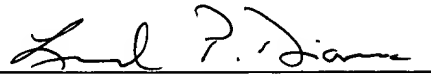
The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

As set out above, the outstanding Office Action should properly be non-final; nonetheless, even if its finality be deemed proper, this Amendment After Final Action is believed clearly to place this application in condition for allowance, and its entry is therefore believed proper under 37 C.F.R. § 1.116. In any event, entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, he is respectfully requested to contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Leonard P. Diana", is written over a horizontal line.

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